

DOCKET NO.: IBIS-0403(IBIS0055-100)
SERIAL NO.: 10/071,978

PATENT
FILED:02/06/2002

REMARKS

Claims 1, 3-21 and 63-97 were pending in the application. Claims 2, 22-62, 95 and 98-106 have been canceled without prejudice to their presentation in another application. Claims 1, 11, 63, 64, 73 and 76-81 have been amended, support for which can be found throughout the specification and specifically at the various tables and examples of compounds of the invention. No new matter has been added. Upon entry of the present amendment, claims 1, 3-21, 63-94 and 97 will be pending.

I. Summary of the Claimed Invention

Applicants' invention is directed to, *inter alia*, novel benzimidazoles according to representative structures I and II, and their derivatives that possess antibacterial activity. This invention is also directed to compositions including the benzimidazole derivatives, and methods for using the same.

II. The Claimed Invention Is Novel

Claim 1 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by G.B. Patent No. 1354554 to Helsley (hereinafter, the Helsley reference"). Applicants traverse the rejection and respectfully request reconsideration because the Helsley reference does not teach every feature recited in claim 1.

The amendments made to claim 1 of the present application renders moot this rejection because the present claim does not provide for R₁ to be hydrogen, according to the proviso of the claim.

Thus, the Helsley reference does not teach every feature recited in claim 1 Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §102(b) be withdrawn.

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Claim 1 further stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by D.E. Patent No. 19916460 A1 to Lubish (hereinafter, the Lubish reference"). Applicants traverse the rejection and respectfully request reconsideration because the Lubish reference does not teach every feature recited in claim 1.

The amendments made to claim 1 of the present application renders moot this rejection because the present claim does not provide for R₁ to be hydrogen, according to the proviso of the claim.

Thus, the Lubish reference does not teach every feature recited in claim 1 Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §102(b) be withdrawn.

Claim 63 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Ogura et al. (Journal of Medicinal Chemistry, 1972, Vol. 15, No. 9, Pages 923-926) (hereinafter, the "Ogura reference"). Applicants traverse the rejection and respectfully request reconsideration because the Ogura reference does not teach every feature recited in claim 63, as currently amended.

The amendments made to claim 63 of the present application renders moot this rejection because the present claim does not provide for R₁₅ and R₁₆ to BOTH be either methyl or ethyl.

Thus, the Ogura reference does not teach every feature recited in claim 63 Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §102(b) be withdrawn.

Claim 63 further stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Chernova et al. (Khimilo-Farmasevticheski Zhurnai (1991), 25(1), pages 50-52). (hereinafter, the "Chernova reference"). Applicants traverse the rejection and respectfully request reconsideration because the Chernova reference does not teach every feature recited in claim 63, as currently amended.

The amendments made to claim 63 of the present application renders moot this rejection because the present claim does not provide for R₅₂ and R₅₃ to be NO₂.

Thus, the Chernova reference does not teach every feature recited in claim 63 Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §102(b) be withdrawn.

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Claim 73 stands rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Viaovic et al. (Bioscience, Biotechnology, and Biochemistry, 1992, 56(2), 199-206). (hereinafter, the "Viaovic reference"). Applicants traverse the rejection and respectfully request reconsideration because the Viaovic reference does not teach every feature recited in claim 73, as currently amended.

The amendments made to claim 73 of the present application renders moot this rejection because the present claim does not provide for R_{30} to be alkoxyphenyl or alkylphenyl.

Thus, the Viaovic reference does not teach every feature recited in claim 73 Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §102(b) be withdrawn.

Claims 73-79 stand rejected under 35 U.S.C. §102(b) as allegedly being anticipated by Jerichel et al. D.E. 888032. (hereinafter, the " Jerichel reference"). Applicants traverse the rejection and respectfully request reconsideration because the Jerichel reference does not teach every feature recited in claims 73-79, as currently amended.

The amendments made to claim 73-79 of the present application renders moot this rejection because the present claim does not provide for R_{2a} to be phenyl.

Thus, the Jerichel reference does not teach every feature recited in claim 73-79 Accordingly, Applicants respectfully request that the rejection under 35 U.S.C. §102(b) be withdrawn.

III. The Claims Are Clear And Definite

Claims 1, 3-21 and 63-97 are rejected under 35 U.S.C. §112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as their invention. The Office Action asserts various "R" group definitions and misspelled words in the claims render them indefinite. Although Applicants believe the claims are clear and definite as originally drafted, solely to advance prosecution of the present application, Applicants have amended claims according to the Examiner's suggestions, to be even more clear and

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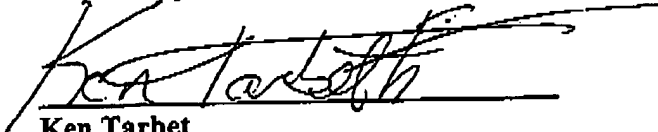
definite. Specifically, R₂₀ has been defined according to corresponding examples found in the various tables of the specification.

Furthermore, claims 11 and 18-19 have been rejected for failure to particularly point out within the claim the exact radicals Applicant wanted to claim. These claims have been correspondingly amended to specifically recite each radical Applicant previously specified. Applicant requests, therefore, that this rejection be withdrawn.

IV. Conclusion

In view of the foregoing, Applicants respectfully submit that the claims are in condition for allowance. An early notice of the same is earnestly solicited. The Examiner is invited to contact Applicants' undersigned representative at (619) 685-1708 if there are any questions regarding Applicants' claimed invention. Attached hereto is a marked-up version of the changes made to the specification and claims by the current amendment.

Respectfully submitted,



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